UNITED STATES PATENT AND TRADEMARK OFFICE

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10/662,337	09/16/2003	Keiko Shiraishi	117194	9255

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 October 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This **FINAL** action is responsive to the amendment filed on 10/20/2008.

2.   In the amendment claims 1-17 remain pending. Claims 1, 10, 11, 12, 13, 16 and 17 are the independent claims.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4.   Claims 1-17 remain rejected under 35 U.S.C. 102(a) as being anticipated by Tatsuo (EP 1 286 254 A2, published Feb 26, 2003).

     Regarding Independent claims 1, 10, 13 and 16, An instruction form retrieval apparatus comprising: A storage part that stores user information and information on an instruction form management apparatus that is connected to the instruction form retrieval apparatus via a network and is holding an at least one selectable instruction form associated with a user based on user access rights, wherein the instruction form is generated in advance, the instruction form and the user information being associated with each other wherein the instruction form includes instructions and indicates a plurality of processing to be executed by a plurality of instruction form execution apparatuses, and is different than any file to be processed by the instructions; A reception part that receives information on a user; A retrieval part that retrieves the instruction form accessible to the user from the instruction form management apparatus based on the received information on the user. An output part that outputs identification information on the retrieved instruction form to allow the user to instruct performing a process indicated in the instruction form to one or more instruction form execution apparatuses connected to the instruction form retrieval apparatus via the network.

     Tatsuo teaches accessing a web server through a network by allowing the user to access an interface and selecting functions that are associated with predetermined processes for processing a plurality of execution apparatuses such as faxing, scanning, copying, printing etc, see fig 1 & 12 & paragraphs 5-8. Furthermore the network holds a user selectable instruction form described in XML for operating the execution apparatuses (paragraphs 121-125 & 157-170).

Tatsuo further describes support for other hardware resources that are external and connected to the MF-apparatus (see fig 1).

Regarding Dependent claim 2, with dependency of claim 1, Tatsuo discloses wherein the output part outputs the Identification information on the retrieved instruction form to the instruction form execution apparatus used by the user (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 3, with dependency of claim 1, Tatsuo discloses wherein the output part outputs the Identification information on the instruction form to a terminal used by the user (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 4, with dependency of claim 1, Tatsuo discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the Identification information on the retrieved instruction form (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 5, with dependency of claim 1, Tatsuo discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to a terminal used by the user, based on the Identification information on the retrieved instruction form (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 6, with dependency of claim 1, Tatsuo discloses wherein the outputted Identification information on the retrieved instruction form is information on the instruction form management apparatus holding the instruction form (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 7, with dependency of claim 1, Tatsuo discloses wherein the outputted Identification

information on the retrieved instruction form includes information to identify the instruction form (See abstract & see

fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 8, with dependency of claim 1, Tatsuo discloses wherein user authentication is

performed using the information on the user (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170,

including the explanation provided in the independent claims).

Regarding Dependent claim 9, with dependency of claim 1, Tatsuo discloses a display information generation part

that generates information to display the information on the retrieved instruction form (See abstract & see fig 1 & 12 &

paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Independent claims 11 and 12, An instruction form execution apparatus comprising: an attachment part

that attaches a portable storage , medium which is unique to and capable of being carried by a predetermined user, the

storage medium holding information on a plurality of instruction form management apparatuses holding at least one

selectable instruction form associated with the user based on user access rights, wherein the instruction form is

generated in advance, wherein the instruction form includes instructions and indicates a plurality of processing to be

executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the

instructions; and an execution part that executes a plurality of processing instructions indicated in the instruction form,

wherein the at least one selectable instruction form is located on at least one server.

Tatsuo teaches accessing a web server through a network by allowing the user to access an interface and selecting

functions that are associated with predetermined processes for processing a plurality of execution apparatuses such as

faxing, scanning, copying, printing etc, see fig 1 & 12 & paragraphs 5-8. Furthermore the network holds a user

selectable instruction form described in XML for operating the execution apparatuses (paragraphs 121-125 & 157-170).

Tatsuo further describes support for other hardware resources that are external and connected to the MF-apparatus (see

fig 1).

Regarding Dependent claim 14, with dependency of claim 13, Tatsuo discloses wherein the information on the

retrieved instruction form is outputted to the instruction form execution apparatus used by the user (See abstract & see

fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Dependent claim 15, with dependency of claim 13, Tatsuo discloses outputting a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the information on the retrieved instruction form (See abstract & see fig 1 & 12 & paragraphs 5-8 & 121-125 & 157-170, including the explanation provided in the independent claims).

Regarding Independent claim 17, An instruction form execution apparatus comprising: an attachment part that attaches a portable storage medium capable of being carried by a user that stores at least one selectable instruction form that includes processing instructions associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form indicates a plurality of processing to be executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the processing instructions; and a processing part that executes the processing instructions based on the instruction form to process information not stored in the storage medium.

Tatsuo teaches accessing a web server through a network by allowing the user to access an interface and selecting functions that are associated with predetermined processes for processing a plurality of execution apparatuses such as faxing, scanning, copying, printing etc, see fig 1 & 12 & paragraphs 5-8. Furthermore the network holds a user selectable instruction form described in XML for operating the execution apparatuses (paragraphs 121-125 & 157-170). Tatsuo further describes support for other hardware resources that are external and connected to the MF-apparatus (see fig 1).

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

5.   Applicant's arguments filed 10/20/2008 have been fully considered but are not persuasive.

Applicant Argues: Ito fails to disclose (1) quoted above because Ito's web interface document list screen provides a list of apparatus and a list of documents for the user to select from. However, a list of apparatus and a list of documents are not "instructions indicating a plurality of processing", as claimed. (pg 11, paragraph 5)

Ito fails to disclose feature (2) quoted above because Ito does not disclose any instruction form that contains instructions indicating a plurality of processing that is associated with a user....the document list screen is not associated with the user, and is not stored in a manner associated with user information, as claimed. (pg 12, paragraph 1)

Ito fails to disclose feature (3) quoted above of a reception part that receives information on a user because Ito does not disclose reception of information on a user. In contrast, the input of the user is limited to selection of which apparatus to utilize and which document is to be processed. (pg 12, paragraph 2)

Ito fails to disclose feature (4) quoted above of a retrieval part that retrieves an instruction form accessible to the user from the instruction form management apparatus based on the received information on the user because the user selects...the document list screen is displayed as a result of the user selecting, not based on information on the user, as claimed. (pg 12, paragraph 3)

Ito fails to disclose feature (5) quoted above of an output part that outputs identification information on the retrieved instruction form because Ito discloses that the user selects button 651 to display a list of apparatuses that can be used to process documents. Once an apparatus is selected, the processing to take place is already determined. Further the list of apparatuses is provided by the SF-appliance 100 but is not derived from any instruction form, thus the claimed output part that outputs Identification info on the retrieved instruction form is not taught. (pg 12, paragraph 4)

Ito fails to disclose feature (8) quoted above because Ito does not disclose use of any portable medium. (pg 13, paragraph 2)

The Examiner Respectfully Disagrees: See Ito paragraph 12 discloses that the user communicates with the web server such a communication includes a user selecting a document, the document contains instructions for executing an apparatus via a web service client part sending the request from the web server part to the apparatus in accordance with a predetermined message exchange protocol such as SOAP. Furthermore the instructions are associated with a user, because they are based on the user selection. The basic feature of a web server as well known in the art includes user authentication thereby including reception of information on a user allowing access to web services based on information on the user. Finally the reference provides a suggestion for use of a portable medium because Ito shows support for a USB connection for peripherals in fig 2 numeral 1330. Ito in general teaches executing instructions in the form of messages in a web services environment for faxing, printing and scanning.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the

PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner (AU 2178)
January 30, 2009

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Examiner, Art Unit 2178

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	Primary Examiner, Art Unit 2178